REMARKS

This Amendment under 37 C.F.R. §1.116, is in response to the final Office Action mailed August 20, 2008, and is filed together with a Request for Continued Examination (RCE).

The undersigned wishes to thank Exr. Choudhry for his helpful analysis of the arguments presented in the Response filed on October 20, 2008, which analysis is taken into account in the amendments to the claims and arguments presented herewith.

Claims 1-4, 11-20, 23-40 and 27-44 were rejected as being unpatentable over Nachom and Tso. Reconsideration and withdrawal of these rejections are respectfully requested.

The Office again points to the GET command of Nachom as evidence that **user identification information** is sent from Nachom's first server (equivalent to the claimed second server) to Nachom's second server (equivalent to the claimed first server). Specifically, the Office states in the Advisory Action, regarding Nachom:

> **"By knowing which products are of interest to the user, it is implicit that user-specific information (user-identification information) must have been passed as claimed. This is also supported by the fact that user idetifying information is collected at the time of logon."**

However, this interpretation of Nachom is incorrect, and is unsupported by Nachom itself, and looks a lot like (it is implicit that....) a back door inherency argument.

Indeed, Nachom specifically states that

> **"... first server 16 will send a request to the second server 24 to provide information 26 that may be related to the subject matter on site A. Information 26 may be an offer for the sale of a related products and/or services that are provided by site B. Accordingly, an exemplary GET request may be:**
>
> **http://www.bsite.com/upsell.asp?vendor=63452&product1=767656 4&product2=998- 3478"**

Note both the description of the request from the first to the second server and the syntax of the GET command: neither contains any user identification information. The written description tells us that the request is "related to the subject matter on site A" and the syntax of the GET command identifies the vendor (63452) and the products (7676564 and 998- 3478) on site A. Merely stating that "it is implicit" that user-specific information "must have been passed" does not make it so, as such assertion is demonstrably **not** supported by Nachom. In Nachom, the request is related to the subject matter on site A. There is no teaching or suggestion in Nachom that such request or GET command is related to user identification information or that such is sent from Nachom's first to Nachom's second server.

Moreover, such language "it is implicit that" is a backdoor inherency argument. It is submitted that the Examiner has presented no evidence tending to show that persons of skill in this art would necessarily recognize the inherent nature of such user-specific information that "must have been passed" in Nachom's methods and systems. The MPEP is quite clear on this issue:

> **"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)".**

Should the Office repeat such arguments, it is respectfully requested that such a basis in fact (specifically, in the Nachom patent) and/or technical reasoning that would reasonably support the Office's contention that Nachom implicitly teaches that" user-specific information (user-identification information) must have been passed as claimed".

The Examiner, in this case, has failed to provide such a basis in fact and/or technical reasoning to support his contention that the allegedly implicit or inherent step is necessarily, implicitly or inherently present in the applied art.

Nachom at no place teaches or suggest that user identification information is used by the second server 24 to "provide an offer that may be related to the subject matter of site A and in the general interest of the client user" Col. 5, lines 28-30. The offer in question is "related to the subject matter of site A" and may be "in the general interest of the client user" because the GET command specified the products currently displayed by the user on site A. No user-identification information is used in Nachom by the second server to provide the information 26.

➔ In fact, site B only learns of the user information when and if the user decides to purchase a product or service from the resultant popup or URL provided by site B (provided or pointed to by the popup or URL provided by the second server 24), and requests billing and user information – see Col. 5, lines 51-65:

> **Site B determines which product and/or service to present to the user 42 and provides the user with the product 44 in the form of information 26. Information 26 also informs the user that if accepted, Site A will share user billing information with Site B 46. If third actuation means 32 is selected, the information 26 will be withdrawn 48. If second actuation means 30 is selected, the user assents to information 50 and site B records the transaction. Site B issues a request to Site A for billing & user information 54 that may be expressed in an exemplary fashion as:**
>
> **https://www.asite.com/completerecord.asp?order=63452&upsell=774624**
>
> **In response to the request from site B, site A provides complete billing and user information to site B 56 over a preferably secure connection.**

However, such user-identification information is not provided to the second server when the initial request for content is sent thereto, and is not used by Nachom's second server in

providing the requested information (a pop-up screen or an embedded hyperlink – see Col. 5, lines 31-32).

As user-identification, in Nachom, is not sent to the second server together with the request for information, the remaining argunents in the Advisory Action also fall, as being based upon a premise that is unsupported by the applied reference.

To make it explicit that the claimed second server sends both the collected user identification data and a request for content to the first server, claim 1 has been amended to recite:

> **the second server sending the collected user identification data and a request for content to the first server;**

Therefore, to render the claimed embodiment obvious, the applied combination must teach or suggest that a second server sends both the collected user identification data and a request for content to a first server. The Nachom/Tso combination neither teaches nor suggests any such step. In the claimed embodiment, the functionality of the remaining step is dependent upon the sending of the user identification data to the first server. Indeed, if such is not sent, the steps of claim 1 ...

> **the first server retrieving user information corresponding to the user identification data from a database of user information accessible to the first server;**
>
> **the first server applying the retrieved user information to a rule base including a plurality of rules;**
>
> **the first server servicing the request for content by selecting advertising to be displayed on the second server's Web site based upon a result of the application of the retrieved user information to at least one of the plurality of rules;**
>
> **the first server sending an address of the selected advertising to the accessing computer, and**
>
> **causing the accessing computer to fetch the selected advertising from the address sent to the accessing computer and to integrate the fetched advertising into a currently displayed page of the Web site.**

...could not be carried out. It follows that Nachoim, failing to teach or to suggest the sending of user-identification data and the request for content, could not be said to teach or to suggest any of such steps, whether considered alone or in combination with Tso, which does not remedy the aforementioned lacunae of Nachoim.

Claims 18 and 35 have been amended in a manner that is similar to the amendments to claim 1.

The arguments advanced in the Response of October 20, 2008 are incorporated herein by reference, rather than repeat them in full herein. Reconsideration and withdrawal of the 35 USC §103(a) rejections applied to the above-listed claims are, therefore, respectfully requested.

Applicants believe that this application is now in condition for allowance. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

Respectfully submitted,

Date: November 20, 2008

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